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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,766	11/23/2001	Sho Kuwamoto	07844-729001	5315

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EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

NOTIFICATION DATE	DELIVERY MODE
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09/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 09/991,766	Applicant(s) KUWAMOTO ET AL.	
	Examiner LAURIE RIES	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment, filed 23 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11-19, 29, 47, 49-51, 53 and 59-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-18, 49, 50 and 59-76 is/are allowed.
- 6) ☒ Claim(s) 9, 19, 29, 47, 51 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 23 June 2008, to the Original Application filed 23 November 2001.
2. Claims 9, 11-19, 29, 47, 49-51, 53, and 59-76 are pending. Claims 1-8, 10, 20-28, 30-46, 48, 52, and 54-58 have been cancelled. Claims 59-76 have been added. Claims 9, 11, 19, 29, 59, and 68 are independent claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClendon (U.S. Patent 6,625,619 B1, claiming priority of U.S. Provisional

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Application Number 60/190,225), in view of Lecluse ("A Generalized Online Delivery Paradigm for XML Information"), hereafter referred to as Lecluse.

As per independent claims 9, 19, and 29, McClendon teaches a method of retrieving a file including HTML data and having a filename including retrieving the file (See McClendon, Column 3, lines 55-67).

McClendon also teaches including a shadow file, or companion file, in an XML format, having a file name that associates it with the original HTML file and containing property set information about the HTML file that is not included within the HTML file (See McClendon, Column. 17, lines 64-67).

McClendon does not teach expressly that the shadow or companion file includes the file name of the file, however, since it was generally well known at the time of the invention to name file containing property set data, such as an XML file associated with an HTML file, identically to the file it defines, differing only in the file extension, it would have been obvious to assume that the shadow or companion file includes the file name of the HTML file. The motivation for doing so would have been to maintain the association between the HTML file and the XML file that contains property set values pertaining to the HTML file.

McClendon also does not teach expressly accessing a parameter stored in the shadow file to determine that the shadow file is to be displayed, and displaying one or more items of information included in the shadow file based on the parameter.

Lecluse teaches an XML file that includes within the file a parameter that indicates portions of the XML file to be displayed (See Lecluse, Page 7, second example).

McClendon and Lecluse are analogous art because they are from the same field of endeavor of manipulating XML data.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the parameter indicating portions of an XML file to be displayed, as taught by Lecluse, with the XML shadow or companion XML file of McClendon. The motivation for doing so would have been to display certain tags indicated within the XML file, thus controlling the overall layout and formatting of the resulting HTML data (See Lecluse, Page 6, "Templates: The Central Component").

Therefore, it would have been obvious to combine Lecluse with McClendon for the benefit of displaying certain tags indicated within the XML file, thus controlling the overall layout and formatting of the resulting HTML data, to obtain the invention as specified in claims 9, 19, and 29.

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4. Claims 47, 51, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClendon (U.S. Patent 6,625,619 B1, claiming priority of U.S. Provisional Application Number 60/190,225), in view of Lecluse ("A Generalized Online Delivery Paradigm for XML Information"), hereafter referred to as Lecluse) as applied to claims 9, 19, and 29 above, and further in view of Lakis (U.S. Patent 5,864,865).

As per dependent claims 47, 51, and 53, McClendon and Lecluse teach the limitations of claims 9, 19, and 29 as described above. McClendon and Lecluse do not teach expressly that the information related to the file and not contained within the file includes a key and a corresponding value. Lakis teaches that data may be displayed in a separate window (See Lakis, Abstract). McClendon, Lecluse and Lakis are analogous art because they are from the same field of endeavor of presenting electronic information to a user in an organized display format. At the time of the invention it would have been obvious to one of ordinary skill in the art to include the display of information in a separate window, as taught by Lakis, with the information related to a file and not contained within the file, as taught by McClendon and Lecluse. The motivation for doing so would have been to display information to the user in an ordered and easily understandable manner (See Lakis, Abstract). Therefore, it would have been obvious to combine Lakis with McClendon and Lecluse for the benefit of displaying information to the user in an ordered and easily understandable manner to obtain the invention as specified in claims 47, 51, and 53.

Response to Arguments

5. Applicant's arguments filed 23 June 2008 have been fully considered but they are not persuasive.

Applicant argues that Lecluse has not been established as prior art because it is not shown that the Lecluse reference cited in the Office action filed 21 March 2008 was publicly available on November 1998, the date printed on the upper left-hand side of page 1 of the Lecluse reference cited in the Office action filed 21 March 2008. To clarify matters for the purpose of appeal, the Office has provided a new copy of the Lecluse reference with additional preliminary pages provided in order to show that the Lecluse reference was presented at the GCA Conference, XML 98, publicly held in Chicago, December 1998, as listed on Page i of the Lecluse reference provided herein (<http://www.infoloom.com/gcaconfs/WEB/TOC/gcaotoc.HTM>). Following this link, Pages ii-iii of the Lecluse reference provided herein further list the Table of Contents for the XML 98, Chicago, GCA Conference (<http://www.infoloom.com/gcaconfs/WEB/TOC/chicago98toc.HTM>), including the Lecluse reference (See Page 2, line32). Following this link, Page iv of the Lecluse reference provided herein further lists the title of the Lecluse reference as cited in the Office action filed 21 March 2008 (http://www.infoloom.com/gcaconfs/WEB/TOC/t0274_.HTM). Following this link, Pages 1-10 of the Lecluse reference provided herein is a duplicate

copy of the Lecluse reference as cited in the Office action filed 21 March 2008 (<http://www.infoloom.com/gcaconfs/WEB/chicago98/lecluse.HTM>).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Applicant argues that Lecluse fails to teach or suggest accessing the parameter stored in the shadow file to determine that the shadow file is to be displayed, as recited in claim 9. The Office respectfully disagrees. Lecluse teaches a parameter stored in one file indicating that a portion of the file is to be displayed, such as applying a rendering style from a template that includes a parameter indicating that the content is to be rendered, and rendering, or displaying, the portion of the template file that includes the replacement content (See Lecluse, Page 7, second example). McClendon teaches a shadow file. At the time of the invention it would have been obvious to one of ordinary skill in the art to include the parameter indicating portions of an XML file to be displayed, as taught by Lecluse, with the XML shadow or companion XML file of McClendon. The motivation for doing so would have been to display certain tags indicated within the XML file, thus controlling the overall layout and formatting of the resulting HTML data (See Lecluse, Page 6, "Templates: The Central Component").

Applicant argues that it was not generally well known at the time of the invention to name a file containing property set data, such as an XML file associated with an HTML file, identically to the file it defines, differing only in the file extension. For the

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purpose of appeal, and as requested by Applicant, the Office provides the following as evidence of the assertion that the above-listed limitation was well known in the art at the time of the invention: U.S. Patent 6,374,268 B1, filed 14 April 1998, to Testardi, discloses a shadow file that shares the same name as the original file (emphasis added, See Testardi, Column 10, lines 25-27). As further evidence, U.S. Patent 5, 911,776, filed 18 December 1996, to Guck, discloses a source file, named INFO.RTF, with at least one corresponding shadow file that includes the name of the source file, INFO.TIFF (See Guck, Figure 2A).

Allowable Subject Matter

6. Claims 11-18, 49-50, and 59-76 are allowed. The following is a statement of reasons for the indication of allowable subject matter: The prior art, namely McClendon and Lecluse, taken alone or in combination fails to teach or suggest the limitations of the claimed invention, specifically a shadow file keys/values manager having an input operatively coupled for receiving in a web authoring tool the information related to the file and not contained in the file.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton, can be reached at (571) 272-4137.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laurie Ries/
Primary Examiner
Technology Center 2100
23 September 2008